

**REMARKS**

Claims 9, 12 and 13 are pending in this application. By this Amendment, claims 9 and 12 are amended. Claims 10 and 11 are canceled without prejudice to, or disclaimer, of the subject matter recited in those claims. Claim 13 is added. No new matter is added.

Reconsideration based on the arguments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments:

(a) place the application in condition for allowance for the reasons discussed below; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

The Office Action rejects claims 9 and 10 under 35 U.S.C. §102(e) over U.S. Patent No. 7,003,355 to Suaning et al. (Suaning). The rejection of claim 10 is moot in view of the cancellation of claim 10. The rejection is respectfully traversed with respect to claim 9.

Claim 9 recites, among other features, placing a receiver at a position under a skin of a temporal region of a patient's head away from the patient's eye; placing a converter at a position under the skin of the temporal region of the patient's head away from the patient's eye, the converter being adapted to be connected to the receiver and convert the received data for electrical stimulation pulse signals to electrical stimulation pulse signals; placing an electrode array between a choroid and a sclera of the patient's eye; and placing a single indifferent electrode in the patient's eye by piercing the eye from outside, the indifferent electrode having an opposite polarity to that of the stimulation electrodes. Suaning does not teach or suggest these features.

Suaning discloses a stimulation method in which a plurality of stimulating electrodes is placed in contact with the surface of a sclera forming the outside of the eye, a plurality of reference electrodes is placed in a vitreous body, and a current is applied to between the stimulating electrodes and the reference electrodes to pass through a retina, thereby stimulating the retina. However, Suaning does not teach, nor can it reasonably be considered to have suggested, placing a receiver and/or a converter at a position under the skin of a temporal region of a patient's head as claim 9 recites. Rather, Suaning discloses that stimulating electronics 42, which analyze the received data and transmit the specific stimulating event, may be positioned at various locations, spaced from the retina, on and within the eye.

Moreover, as discussed above, Suaning discloses a plurality of reference electrodes placed in a vitreous body. The plurality of reference electrodes, therefore, requires a circuit for controlling them. However, in contrast, claim 9 recites a single indifferent electrode, which is arranged to stimulate the retina; thus providing a more effective and prompt visual restoration. Suaning also fails to teach this feature.

Furthermore, although Suaning discloses that electrodes 50, 60 may be positioned in close proximity to the sclera 74 at various locations such that the electrode engages the sclera 74, or penetrates the sclera 74 (col. 4, line 57 - col. 5, line 10), Suaning does not teach placing an array of electrodes between the choroid and the sclera of a patient's eye, as claim 9 recites.

In view of the above, Suaning cannot reasonably be considered to teach or to have suggested the combination of all of the features positively recited in claim 9. Accordingly, reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. §102 are respectfully requested.

The Office Action rejects claims 9, 10 and 12 under 35 U.S.C. §102(b) over

WO 00/56393 to Greenberg et al; and rejects claim 12 under 35 U.S.C. §103(a) over Suaning in view of WO 00/56393. The rejection of claim 10 is moot in view of the cancellation of claim 10. The rejections are respectfully traversed with respect to claims 9 and 12.

Claim 9 recites, among other features, placing an electrode array between a choroid and a sclera of the patient's eye; and claim 12 recites placing an electrode array in a sclerotic flap. Neither Suaning nor WO 00/56393 teaches, nor can they reasonably be considered to have suggested, either of these features.

Suaning does not teach these features for the reasons discussed above with respect to claim 9. Furthermore, although Suaning discloses that the electrode may penetrate the sclera, Suaning does not teach, nor can it reasonably be considered to have suggested, placing an electrode array within a sclerotic flap, as positively recited in claim 12.

WO 00/56393 teaches that an electrode array constituted of a plurality of stimulation electrodes is placed on a retina to stimulate the retina. However, WO 00/56393 does not teach that stimulation electrodes are placed between a choroid and a sclera, or in a sclerotic flap, and a current is applied to between the stimulation electrodes and the reference electrode (indifferent electrode). In contrast, WO 00/56393 teaches that an electrode array 811 may be located inside the eye 812 in the vitreous humor. Thus, the electrode array in WO 00/56393 is positioned neither between the choroid and the sclera, nor within a sclerotic flap, as claims 9 and 12 recite, respectively.

In view of the above, Suaning and WO 00/56393, taken alone or in any permissible combination, do not teach, nor would they reasonably have suggested, the subject matter of claims 9 and 12. Accordingly, reconsideration and withdrawal of the rejections of claims 9 and 12 under 35 U.S.C. §§ 102 and 103 are respectfully requested.

The Office Action rejects claim 11 under 35 U.S.C. §103(a) over Suaning or WO 00/56393 in further view of U.S. Patent No. 2,760,483 to Tassicker or U.S. Patent No.

6,427,087 to Chow et al. (Chow). The rejection of claim 11 is moot in view of the cancellation of claim 11.

Added claim 13 also recites the features placing an electrode array in a sclerotic flap, similar to the features of claim 12. Claim 13 is similar to all features of claim 12, with the exception that claim 12 recites a photographing unit outside a patient's "head" and placing a "single" indifferent electrode, while claim 13 recites a photographing unit outside a patient's "eye" and placing an indifferent electrode. Thus, claim 13 is allowable over Suaning and WO 00/56393 for the same reasons discussed above that claim 12 is allowable.

Furthermore, Tassicker and/or Chow do not cure the deficiencies in the application of Suaning and WO 00/56393 to the subject matter of the pending claims. The apparatus disclosed in each of Tassicker and Chow (1) has no photographing device outside the eye, and (2) is arranged to directly receive the light entering the eye by a photodetector or stimulator and output a stimulation signal as a result of receiving the light to stimulate a retina. Accordingly, the photodetectors or stimulators disclosed in Tassicker and Chow must be placed in a position where the light entering the eye can be received. Such a photodetector or stimulator cannot be used if placed between a choroid impenetrable to light and a sclera outside thereof.

Further, the alleged motivations to combine presented in the abbreviated conclusory form "[t]o have positioned the receiver and converter of Suaning" or "[t]o have placed the electrode array either between the choroid and the sclera or choroid and retina through a sclera flap would have been obvious in view of Chow or Tassicker" are not enough to prove that there is a teaching, suggesting or motivation in the prior art to combine the references in the manner suggested by the Office Action. The Federal Circuit recently reaffirmed its prior holdings asserting that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness." *In re Kahn*, Appeal No. 04-1616, March 22, 2006 (Fed. Cir.) (quoting *In re Lee*" 277 F.3d 1338,1343 46 (Fed. Cir. 2002)). This standard is not met here as no articulated reasoning with some rational underpinning is provided.

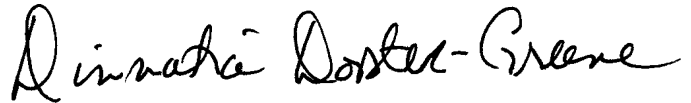
Additionally, based on significantly varying methodologies by which the inventions of Suaning and WO 00/56393, and the inventions of Tassicker and Chow operate, simply stating that these references are combinable in any manner overlooks the reasonable conclusion that such a combination would result in improperly modifying the principle of operation of one or the other of the references. A conclusion of obviousness based on such a combination cannot be sustained.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the result in combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" *See, e.g., In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It is respectfully submitted that the rejections of any of the pending independent claim is improper in view of at least MPEP §2143.01, and the above cited judicial precedent, because the Office Action lacks the required specific evidence of a teaching, suggest or motivation in the prior art for one of ordinary skill to have combined the references in the manner suggested in order to render the subject matter of the pending claims obvious over any permissible combination of those references.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 9, 12 and 13 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Petition for Extension of Time

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